REMARKS

The Examiner has not returned a signed copy of Form PTO/SB/08 A&B (modified) filed with Applicants' Information Disclosure Statement of December 10, 2002. Applicants respectfully request that the Examiner return a signed copy with the next communication from the PTO.

In this Amendment, claims 1, 7, 12 and 21 have been amended to delete the recitation of "an acyl group."

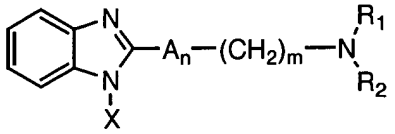
Applicants submit that entry of the present Amendment after final Office Action is appropriate, because the amendments represent mere deletions from the recited compounds. Upon entry of the present Amendment, claims 1-12, 14-18, 20 and 21 will be all the claims pending in the application.

On page 2 of the Office Action, claims 1-12 and 21 have been rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Giani et al.

Applicants respectfully submit that claims 1-12 and 21 as amended are not obvious over Giani et al.

Giani et al teaches benzimidazole derivatives (I) having an antihistaminic activity, wherein A represents $-CH_2CH(CH_3)-$ or $-CH(CH_3)CH_2-$, n is 0 or 1; m represents 0 or an integer of from 1 to 5, X represents a radical selected from the group consisting of benzyl, fluorobenzyl, alkoxyalkyl and tetrahydrofurfuryl, R_1 and R_2 each represents a saturated or unsaturated alkyl radical, or they may form, together with the adjacent nitrogen atom, an optionally substituted

heterocyclic ring selected from the group consisting of pyrrolidine and piperidine, and corresponding pharmaceutically acceptable acid salts (abstract).



(I)

The compounds disclosed in Giani et al differ from the presently claimed compounds, at least as to the substituents at the nitrogen atom of the piperidine ring, that is, X in formula (I) of Giani et al and R^2 in formula (I) of the present invention.

In Example 4 of Giani et al, 2-(4-piperidin-1-ylbutyl)benzimidazole was used as a starting material to prepare 1-(2-ethoxyethyl)-2-(4-piperidin-1-ylbutyl)benzimidazole, which is a compound having the general formula (I). However, 2-(4-piperidin-1-ylbutyl)benzimidazole itself does not meet the requirements of formula (I), because this compound has a hydrogen atom at the position corresponding to X in formula (I). There is no indication in Giani et al that 2-(4-piperidin-1-ylbutyl)benzimidazole has any pharmaceutical activity.

Therefore, even though 2-(4-piperidin-1-ylbutyl)benzimidazole might be characterized as a homologue of the presently claimed compounds, one of ordinary skill in the art would have no reason to use and modify this compound.

In view of the above, the Examiner is respectfully requested to reconsider and withdraw the rejection.

On page 3 of the Office Action, claims 1, 7, 10, 12 and 21 have been rejected under 35 U.S.C. §112, first paragraph, as allegedly lacking sufficient written description.

Applicants respectfully submit that claims 1, 7, 10, 12 and 21 as amended are sufficiently described in the present specification. In this Amendment, Applicants have amended claims 1, 7, 12 and 21 to delete the recitation of "an acyl group."

The Examiner is kindly directed to the fact that R^3 in claims 1 and 12, is defined as "one or more functional groups on the ring containing the nitrogen atom and A." See, e.g., formula I and Examples 1 to 58.

Regarding the phrase "a phenyl group which may be substituted," it might be broad, but it is not indefinite. The specification does provide examples for such substituent. See Compound No. 45.

In view of the above, the Examiner is respectful requested to reconsider and withdraw the rejection.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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